

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Confirmation No.: 1772
Inventor(s):
Scott Lorenz

Examiner: Bleck, Carolyn P.
Group/Art Unit: 3626
Atty. Dkt. No: 5053-36000

Title: INTERNET-ENABLED
SYSTEM AND METHOD
FOR ASSESSING
DAMAGES

CERTIFICATE OF MAILING
UNDER 37 C.F.R. §1.8

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Commissioner for Patents
Alexandria VA 22313

B. Gail Ballard

APPEAL BRIEF

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant submits the following Appeal Brief in support of claims 1-11, 13-18 and 20-22 of the above-referenced application. Appellant submits that each of these claims is patentable and in condition for allowance.

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I. Real Party in Interest

The Real Party in Interest for the appealed application is Computer Sciences Corporation, a corporation having a place of business at 200 West Cesar Chavez, Austin, Texas 78701.

II. Related Appeals and Interferences

There are no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 1-27 have been entered in the case. Claims 12, 19 and 23-27 have been cancelled. Claims 1-11, 13-18 and 20-22 are pending. Claims 1-11, 13-18 and 20-22 have been rejected. No claims have been allowed.

IV. Status of Amendments

Amendments to the claims were submitted in response to the final Office Action mailed June 18, 2004. In an Advisory Action mailed November 12, 2004, the Examiner indicated that the amendments were entered. The Appellant is filing an amendment making minor corrections to claims 13, 14, 20 and 21 concurrently with this appeal brief. For the reasons explained in the Remarks section of that amendment, appellant believes that that amendment is entitled to entry under the standards set forth in MPEP §1207.

V. Summary of Claimed Subject Matter

This invention generally relates to methods, systems and carrier mediums for processing insurance claims. See Specification, page 3, lines 3-4 (all future page, paragraph, and line references in this section refer to the Specification unless otherwise indicated).

Insurance companies may use computer-based and knowledge-based claim-processing systems to process, evaluate, analyze and estimate insurance claims in a fair and consistent manner. A knowledge-based claim-processing system includes an expert system which utilizes and builds a knowledge base to assist the user in decision making. Such a system may allow the insurance companies to define new rules and/or use previously defined rules, in real-time. (See page 1, line 26 to page 2, line 2).

In the past, such knowledge-based systems for estimating the value of an insurance claim have been limited to traditional computing architectures such as mainframes and stand-alone personal computers. Therefore, it was necessary to install and maintain client software as well as server software for these knowledge-based systems in particular physical locations. With the growth of the Internet, however, many personal computers may now be granted client access to servers distributed all over the world. (See page 2, line 11 to page 2, line 17).

Recognizing the drawbacks of conventional insurance claim processing software, Appellant developed a new method, system and carrier medium for processing insurance claims.

In an embodiment, a system for processing insurance claims includes an insurance claim processing server and a client computer. The insurance claim processing server includes a first CPU and a first memory coupled to the first CPU. The first memory stores a first set of program

instructions which are executable by the first CPU to estimate a value of an insurance claim. (See page 3, lines 4-9) The first set of program instructions further includes a sequence of insurance claim processing steps executable to complete an insurance claim transaction. The number of insurance claim processing steps and/or the sequence of execution of the insurance claim processing steps are established dynamically in real time. (See page 13, lines 21-27)

The client computer includes a second CPU and a second memory coupled to the second CPU. The client computer system is coupled to the insurance claim processing server through a network. The second memory of the client computer stores a second set of program instructions. The second set of program instructions are executable by the second CPU to receive the insurance claim assessment data entered by a user and to send the insurance claim assessment data across the network to the insurance claim processing server. (See page 3, lines 18-26) The second set of program instructions include a sequence of steps established dynamically in real time. (See page 12, lines 9-21)

In an embodiment of a method, processing of insurance claims using an insurance claim processing server includes receiving insurance claim assessment data. The insurance claim assessment data is entered by a user in response to a plurality of insurance claim assessment questions during an insurance claim consultation session. The insurance claim assessment data is then sent across a network via one or more Internet protocols to an insurance claim processing server. The insurance claim processing server executes insurance claim processing steps to estimate a value of an insurance claim as a function of the insurance claim assessment data. (See page 3, lines 3-29). The number of insurance claim processing steps and/or sequence of execution of the insurance claims processing steps are established dynamically in real time. (See page 13, lines 21-27).

In an embodiment, a carrier medium includes program instructions computer-executable to implement a method of processing of insurance claims using an insurance claim processing server. (See page 9, lines 11-16). The method of processing insurance claims includes receiving insurance claim assessment data. The insurance claim assessment data is entered by a user in response to a plurality of insurance claim assessment questions during an insurance claim consultation session. The insurance claim assessment data is then sent across a network via one or more Internet protocols to an insurance claim processing server. The insurance claim processing server executes insurance claim processing steps to estimate a value of an insurance claim as a function of the insurance claim assessment data. (See page 3, lines 3-29). The number of insurance claim processing steps and/or sequence of execution of the insurance claims processing steps are established dynamically in real time. (See page 13, lines 21-27).

VI. Grounds of Rejection to be Reviewed on Appeal

1. Claims 1-2, 5-11, 13-18, and 20-22 are finally rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,950,169 to Borghesi et al. (hereinafter “Borghesi”) in view of U.S. Patent No. 6,505,176 to DeFrancesco, Jr. et al. (hereinafter as “DeFrancesco”).
2. Claims 3 and 4 are finally rejected under 35 U.S.C. §103(a) as being obvious over Borghesi in view of DeFrancesco and further in view of U.S. Patent Published Patent Application No. 2002/0035488 to Aquila et al. (hereinafter “Aquila”).

VII. Argument

First Ground of Rejection:

Claims 1-2, 5-11, 13-18, and 20-22 are finally rejected under 35 U.S.C. §103(a) as being obvious over Borghesi in view of DeFrancesco. Appellants traverse this rejection for the following reasons. Different groups of claims are addressed under their respective subheadings.

Claim 1

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner et al.*, 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (emphasis added) *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03. “All the words in a claim must be considered in judging the patentability of that claim against the prior art.” (emphasis added) *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970). In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 1 describes a combination of features including:

an insurance claim processing server comprising a first CPU and a first memory coupled to the first CPU, wherein the first memory stores a first set of program instructions which are executable by the first CPU to: estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the first set of program instructions further comprise a sequence of insurance claim processing steps executable to complete an insurance claim transaction

Appellant respectfully submits that the cited art does not appear to disclose at least the above features of claim 1.

The Examiner states, in the final Office Action mailed June 18, 2004:

Borghesi discloses a system for managing insurance claim processing comprising: (a) a communication server for insurance claim management comprising a processor coupled to memory, wherein the memory is embodied as a mass storage device and storing a program constructed using known software tools and languages, wherein the program is used for ... transmitting, from a remote computer, a predetermined amount of data related to calculating a total loss valuation to the server, wherein the predetermined amount of data is input by a user through a user interface, wherein the total loss valuation is then sent back to the remote computer...;

In an Advisory Action, mailed on November 12, 2004, the Examiner further amends the rejection of the claims with respect to Borghesi by stating that:

It is respectfully submitted that the Borghesi's communications server performs the functions of claims 1 and 29. While the server may not be named an "insurance claim processing server," it still is capable of estimating the value of an insurance claim.

The Examiner appears to take the position that Borghesi's disclosure of a communication server teaches or suggests an insurance claim processing server as recited in Appellant' claim 1. Appellant respectfully disagrees with the Examiner's position. Borghesi states:

The system 28 preferably comprises computer terminals or networks at an insurance company home office 30, a local claims office 32 and an auditor 34. Each of these computers is in communication with a communication server 36 over a communication line 37 such as telephone lines or wireless communications facilities. The communication server 36 may be a specialized server dedicated to insurance claim management, such as the EZNET server provided by CCC Information Services, Inc., or a general wide area network provider such as America On Line (AOL). The server 36 preferably has a plurality of flexible

memory locations, or mailboxes, for storing insurance datafiles and communications. Computers located at an appraiser 38, direct repair program (DRP) facility 40, or independent appraiser 42 are also in communication with the server 36 over a communication line. The computer of the home office 30 preferably holds the mastercopy of each insurance datafile unless the assigned appraiser 38, DRP shop 40 or independent appraiser 42 is working on the specific insurance claim assignment associated with a datafile.
(Borghesi, col. 5, line 55 to col. 6, line 5)

FIG. 3 of Borghesi discloses a “communication server” connected to various computers. Borghesi appears to teach a communication server for passing information among remote computers, such as computers located at an insurance company home office, local claims office, or appraiser. Borghesi does not appear to teach or suggest that the communications server includes software that estimates a value of an insurance claim. Instead, Borghesi appears to teach remote computers that can access a communication server. Some of the remote computers are used to collect and transmit information related to automobile insurance claims. Other of the remote computers (for example, the remote computers located at the insurance companies home) are used to perform functions related to the processing of the insurance claim. Borghesi does not appear to teach or suggest that this communication server is capable of performing insurance claim processing tasks.

Borghesi states:

communication server 36 may be a specialized server dedicated to claims management such as EZNET server provided by CCC Information Services, Inc., or a general wide area network provider such as America On Line.
(Borghesi, col. 5, lines 58-62)

The recited statement in Borghesi appears simply to teach that the communication server can be dedicated to insurance claims management, as contrasted with a general WAN provider such as America On Line that also communicates information unrelated to insurance claims. The statement does not appear to teach or suggest an insurance claims processing server that includes

a memory storing program instructions comprising a sequence of insurance claim processing steps executable to complete an insurance claim transaction. Appellant notes that the federal trademark registration for the EZNET mark states that the EZNET mark is used “for electronic communications network services which allow communication among insurance claims offices, automobile repair facilities, automotive parts suppliers, car rental agencies, and other entites related to automotive collision repair services.” See Trademark Electronic Search System (TESS) record for EZNET, Registration No. 2249451 (emphasis added). There Examiner has provided no evidence that the EZNET server is capable of estimating a value of an insurance claim.

The Examiner also cites language in claim 5 of Borghesi (Borghesi, col. 21, lines 30-35) and claim 29 of Borghesi (Borghesi, col. 23, lines 17-34). Neither of these claims, however, appears to teach or suggest an insurance claims processing server comprising a memory storing a first set of program instructions executable to estimate a value of an insurance claim as a function of insurance claim assessment data and a sequence of processing steps executable to complete an insurance claim transaction. Claim 5 of Borghesi states “transmitting a predetermined amount of data related to calculating a vehicle total loss valuation to the server, receiving the total loss valuation at the remote computer, and appending the total loss valuation to the datafile.” (Borghesi, col. 21, lines 30-35). The Examiner apparently interprets this language as suggesting that the communication server estimates the value of an insurance claim. The language of claim 5 does not state that the communication server estimates the value of an insurance claim. Moreover, the detailed description and drawings in Borghesi do not appear to teach or suggest a communication server performing such a function. Instead, the detailed description appears to teach or suggest that the total loss valuation is received from a home office computer (Borghesi, col. 10, lines 6-11; col. 11, lines 33-35) or from a third party provider (Borghesi, col. 13, lines 45-57; col. 10, lines 26-28) and the received information is added to the datafile.

In addition, claim 1 of Borghesi, from which claim 5 depends, describes a method comprising “building sections of the datafile at the remote computer using information accessed from an external source to the remote computer” (Borghesi, col. 21, lines 9-12) (emphasis added) and claim 5 describes “receiving the total loss valuation at the remote computer, and appending the total loss valuation to the datafile.” (Borghesi, col. 21, lines 30-35) (emphasis added). Clearly processing of the insurance claim is performed at the remote computer, not at the “communications server.” Appellant would respectfully request that the Examiner particularly cite the sections of Borghesi that allegedly teach that Borghesi’s communications server performs the processing of the insurance claim.

Borghesi further states:

Each remote computer, whether a single user computer or a computer in a local area network, provides an interface for a user to access the assigned or pertinent claim workfile. The user interface not only comprises a video display of monitor, but also includes a universal display screen. The universal display screen, preferably a graphic user interface, displays at least one workfile/datafile in addition to visual objects representative of actions to be taken on a workfile. In a preferred embodiment where the universal entry screen is the graphic user interface described above, an opened insurance claim datafile has a plurality of tabbed sections, each tabbed section representing a separate view of the datafile. A user may access each of the tabs by using a keyboard or other user input means. (Borghesi, Col. 7, lines 40-51)

When an existing workfile is opened or a new workfile created, the user may next begin substantive work on the workfile. As shown in FIG. 8E, all of the various tabbed sections in a workfile as described above are available for alteration and amendment. Specifically, the user may create or edit administrative data 200, create or edit vehicle information 202, create or edit an estimate of damage 204, update an event log 206, review the totals in the workfile 208, add to or edit notes 210, edit labor rates in the workfile for the various approved repair facilities 212, begin a vehicle valuation process 214, update salvage information 216 or simply review correspondence 218. In a preferred embodiment, each of these tasks may be accomplished through the graphic user

interface described above by selecting the appropriate tabs and frame switching buttons on the computer screen.
(Borghesi, Col. 11, line 65 to Col. 12, line 13)

Appellant submits that Borghesi appears to teach that a user of a computer system logs onto a remote computer, i.e., a computer that is coupled to the communication server. This computer includes a graphical interface such as depicted in FIGS. 6 and 7 that allows a user of the remote computer system to access the various options available for processing the insurance claim. Appellant notes that Borghesi specifically teaches that each remote computer system includes the graphical interface that allows the user to perform estimates of the insurance processing claims.

Appellants claimed system differs from the system of Borghesi in that the processing of the insurance claims is performed by the insurance claim processing server not by remote computers that access this server. An advantage of such a system is that updates may only need to be performed to the insurance claims processing server to revise the software. Thus, an update of the software may be accomplished without having to update each of the remote computers coupled to the insurance claim processing server. In contrast, Borghesi appears to teach a graphical interface on each of the remote computers. A change in the software of Borghesi would appear to require a change of the graphical interface on each of the remote computers. Appellant submits that there does not appear to be any teaching that the graphical interface software is stored or run from the communication server.

Claim 1 further describes a combination of features including, but not limited to: “wherein the first set of program instructions further comprise a sequence of insurance claim processing steps executable to complete an insurance claim transaction, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.” The Examiner notes that Borghesi “fails to expressly disclose” this feature of claim 1. Nonetheless, the Examiner alleges: “it would

have been obvious to one of ordinary skill in the art to combine the teachings of DeFrancesco within the method of Borghesi with the motivation of allowing steps within a process and the order in which these steps are processed to vary (DeFrancesco; col. 2 lines 3-12) thus reducing the cycle time for development and testing of software and reducing the costs in developing software (DeFrancesco; col. 2 lines 12-24).” Appellant respectfully disagrees with this allegation.

The showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed.

DeFrancesco discloses a workflow management system for credit applications. (DeFrancesco, Abstract). Borghesi relates to insurance claim management software. It is not clear what motivation a person of ordinary skill in the art would have to seek out and incorporate a teaching from a credit application system into an insurance claims management system. Appellant respectfully submits that the Examiner has not provided a motivation for combining the teachings of Borghesi and DeFrancesco without the benefit of the Appellant’s disclosure. Appellant respectfully submits that the Examiner’s rejection of claim 1 is based on hindsight speculation not based on the teachings of the prior art.

For at least these reasons, Appellant submits that claim 1 is allowable over the cited art.

Claim 2

Claim 2 states, in part, “wherein the insurance claim comprises a bodily injury claim, and wherein the estimate of the value of the insurance claim comprises an estimate of bodily injury general damages.” The Examiner alleges: “Borghesi clearly discloses the insurance claim data file comprising data gathered concerning the extent of damage or injury suffered by the insured, insurance claim settlement information including data on satisfying a claim such as estimates and a total loss calculation for a claim.” Appellant submits, however, that none of the passages cited by the Examiner teach estimating “bodily injury general damages” as recited in claim 2.

For example, in one of the passages cited by the Examiner, Borghesi states:

In a preferred embodiment, the datafile contains data on the insured, including policy information; data on a claim, such as the extent of damage or injury; and data on satisfying a claim including repair estimates and total loss valuation of, for example, an automobile.
(Borghesi, col. 2, lines 50-59)

The cited passage appears to relate to the contents of a datafile. Borghesi appears to teach that the datafile may include data regarding the “extent of damage or injury.” Borghesi, however, is silent as to what is done with the information regarding the extent of injury and does not appear to teach that the extent of injury information is processed in any way.

In another passage cited by the Examiner, Borghesi states:

20. The system of claim 14 wherein the insurance claim datafile further comprises: data gathered concerning the extent of damage or injury suffered by the insured; correspondence related to the claim, whereby the correspondence includes form letters sent to the insured; and messages, related to the claim, sent between insurance company employees via electronic mail.
(Borghesi, col. 22, lines 55-62)

Again, Appellant submits that Borghesi does not appear to teach or disclose processing of data concerning the extent of injury to determine “an estimate of bodily injury general damages.” For at least these reasons, and for the reasons recited above with respect to independent claim 1, Appellant submits that claim 2 is patentable over the cited art.

Claim 8

In addition, neither Borghesi nor DeFrancesco appear to disclose, teach, or suggest “one or more treatments of the bodily injuries” as recited in claim 8. Nonetheless, the Examiner states: “The skilled artisan would have found it an obvious modification to include treatments of bodily injury with the system taught collectively by Borghesi and DeFrancesco with the motivation of efficiently managing an insurance claim work flow by performing, evaluation, and documenting all tasks when processing a claim.” The Examiner cites Borghesi, col. 2 lines 20-30 to support the Examiner’s statement, but neither the cited passage nor any other portion of Borghesi appears to teach or suggest insurance claim assessment data comprising bodily injuries and treatments of the bodily injuries.

The showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed.

Appellant submits that a person of ordinary skill in the art, at the time of the invention, would not have combined data comprising bodily injuries and treatments of the bodily injuries with the teachings of Borghesi and DeFrancesco without the benefit of the Appellant’s

disclosure. Appellant respectfully submits that the Examiner's rejection of claim 8 is based on hindsight speculation not based on the teachings of the prior art. For at least these reasons, and for the reasons recited above with respect to independent claim 1, Appellant submits that claim 8 is patentable over the cited art.

Claim 9

Claim 9 describes a combination of features including:

executing insurance claim processing steps on the insurance claim processing server to estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.

Appellant respectfully submits that the cited art does not appear to disclose at least the above features of claim 9.

The Examiner states, in the final Office Action mailed June 18, 2004:

Method claims 9-10 and 13-14 repeat the subject matter of system claims 1-2 and 6, respectively, as a series of steps rather than as a set of apparatus elements. ... As such these limitations are rejected for the same reasons given above for method claims 1-2 and 6.

As noted above, the Examiner appears to take the position that Borghesi's disclosure of a communication server teaches or suggests an insurance claim processing server as recited in Appellant' claim 9. Appellant respectfully disagrees with the Examiner's position.

FIG. 3 of Borghesi discloses a "communication server" connected to various computers. Borghesi appears to teach a communication server for passing information among remote

computers, such as computers located at an insurance company home office, local claims office, or appraiser. Borghesi does not appear to teach or suggest estimating a value of an insurance claim using the communication server. Instead, Borghesi appears to teach remote computers that can access a communication server. Some of the remote computers are used to collect and transmit information related to automobile insurance claims. Other of the remote computers (for example, the remote computers located at the insurance companies home) are used to perform functions related to the processing of the insurance claim. Borghesi does not appear to teach or suggest that this insurance claim processing tasks are preformed by the communication server.

Appellants claimed method differs from the method of Borghesi in that the processing of the insurance claims is performed by the insurance claim processing server not by remote computers that access this server. An advantage of such a method is that updates may only need to be performed to the insurance claims processing server to revise the software. Thus, an update of the software may be accomplished without having to update each of the remote computers coupled to the insurance claim processing server.

Claim 9 further describes a combination of features including, but not limited to: “wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.” The Examiner notes that Borghesi “fails to expressly disclose” this feature. Nonetheless, the Examiner alleges: “it would have been obvious to one of ordinary skill in the art to combine the teachings of DeFrancesco within the method of Borghesi with the motivation of allowing steps within a process and the order in which these steps are processed to vary (DeFrancesco; col. 2 lines 3-12) thus reducing the cycle time for development and testing of software and reducing the costs in developing software (DeFrancesco; col. 2 lines 12-24).” Appellant respectfully disagrees with this allegation.

DeFrancesco discloses a workflow management system for credit applications. (DeFrancesco, Abstract). Borghesi relates to insurance claim management software. It is not clear what motivation a person of ordinary skill in the art would have to seek out and incorporate a teaching from a credit application system into an insurance claims management system. Appellant respectfully submits that the Examiner has not provided a motivation for combining the teachings of Borghesi and DeFrancesco without the benefit of the Appellant's disclosure. Appellant respectfully submits that the Examiner's rejection of claim 9 is based on hindsight speculation not based on the teachings of the prior art.

For at least these reasons, Appellant submits that claim 9 is allowable over the cited art.

Claim 14

Claim 14 states, in part, "wherein the insurance claim comprises a bodily injury claim, and wherein the estimate of the value of the insurance claim comprises an estimate of bodily injury general damages." The Examiner alleges: "Borghesi clearly discloses the insurance claim data file comprising data gathered concerning the extent of damage or injury suffered by the insured, insurance claim settlement information including data on satisfying a claim such as estimates and a total loss calculation for a claim." Appellant submits, however, that none of the passages cited by the Examiner teach estimating "bodily injury general damages" as recited in claim 14.

Appellant submits that the passages cited by the Examiner appear to relate to the contents of a datafile. Borghesi appears to teach that the datafile may include data regarding the "extent of damage or injury." Borghesi, however, is silent as to what is done with the information regarding the extent of injury and does not appear to teach that the extent of injury information is

processed in any way. For at least these reasons, and for the reasons recited above with respect to independent claim 9, Appellant submits that claim 14 is patentable over the cited art.

Claim 15

In addition, neither Borghesi nor DeFrancesco appear to disclose, teach, or suggest “one or more treatments of the bodily injuries” as recited in claim 15. The Examiner cites Borghesi, col. 2 lines 20-30 to support the Examiner’s statement, but neither the cited passage nor any other portion of Borghesi appears to teach or suggest insurance claim assessment data comprising bodily injuries and treatments of the bodily injuries. Appellant submits that a person of ordinary skill in the art, at the time of the invention, would not have combined data comprising bodily injuries and treatments of the bodily injuries with the teachings of Borghesi and DeFrancesco without the benefit of the Appellant’s disclosure. Appellant respectfully submits that the Examiner’s rejection of claim 15 is based on hindsight speculation not based on the teachings of the prior art. For at least these reasons, and for the reasons recited above with respect to independent claim 9, Appellant submits that claim 15 is patentable over the cited art.

Claim 16

Claim 16 describes a combination of features including:

executing insurance claim processing steps on the insurance claim processing server to estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.

Appellant respectfully submits that the cited art does not appear to disclose at least the above features of claim 16.

The Examiner states, in the final Office Action mailed June 18, 2004:

Claims 16-17 and 20-21 repeat the subject matter of system claims 1-2 and 6, respectively, as a carrier medium comprising computer instructions to carry out the functionality of the system from method claims 1-2 and 6. As such these limitations are rejected for the same reasons given above for method claims 1-2 and 6.

As noted above, the Examiner appears to take the position that Borghesi's disclosure of a communication server teaches or suggests an insurance claim processing server as recited in Appellant' claim 16. Appellant respectfully disagrees with the Examiner's position.

FIG. 3 of Borghesi discloses a "communication server" connected to various computers. Borghesi appears to teach a communication server for passing information among remote computers, such as computers located at an insurance company home office, local claims office, or appraiser. Borghesi does not appear to teach or suggest estimating a value of an insurance claim using the communication server. Instead, Borghesi appears to teach remote computers that can access a communication server. Some of the remote computers are used to collect and transmit information related to automobile insurance claims. Other of the remote computers (for example, the remote computers located at the insurance companies home) are used to perform functions related to the processing of the insurance claim. Borghesi does not appear to teach or suggest that this insurance claim processing tasks are preformed by the communication server.

Appellants the method embodied in the claimed carrier medium claims differs from the method of Borghesi in that the processing of the insurance claims is performed by the insurance claim processing server not by remote computers that access this server. An advantage of such a method is that updates may only need to be performed to the insurance claims processing server to revise the software. Thus, an update of the software may be accomplished without having to update each of the remote computers coupled to the insurance claim processing server.

Claim 16 further describes a combination of features including, but not limited to: “wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.” The Examiner notes that Borghesi “fails to expressly disclose” this feature. Nonetheless, the Examiner alleges: “it would have been obvious to one of ordinary skill in the art to combine the teachings of DeFrancesco within the method of Borghesi with the motivation of allowing steps within a process and the order in which these steps are processed to vary (DeFrancesco; col. 2 lines 3-12) thus reducing the cycle time for development and testing of software and reducing the costs in developing software (DeFrancesco; col. 2 lines 12-24).” Appellant respectfully disagrees with this allegation.

DeFrancesco discloses a workflow management system for credit applications. (DeFrancesco, Abstract). Borghesi relates to insurance claim management software. It is not clear what motivation a person of ordinary skill in the art would have to seek out and incorporate a teaching from a credit application system into an insurance claims management system. Appellant respectfully submits that the Examiner has not provided a motivation for combining the teachings of Borghesi and DeFrancesco without the benefit of the Appellant’s disclosure. Appellant respectfully submits that the Examiner’s rejection of claim 9 is based on hindsight speculation not based on the teachings of the prior art.

For at least these reasons, Appellant submits that claim 16 is allowable over the cited art.

Claim 21

Claim 21 states, in part, “wherein the insurance claim comprises a bodily injury claim, and wherein the estimate of the value of the insurance claim comprises an estimate of bodily injury general damages.” The Examiner alleges: “Borghesi clearly discloses the insurance claim data file comprising data gathered concerning the extent of damage or injury suffered by the insured, insurance claim settlement information including data on satisfying a claim such as estimates and a total loss calculation for a claim.” Appellant submits, however, that none of the passages cited by the Examiner teach estimating “bodily injury general damages” as recited in claim 21.

Appellant submits that the passages cited by the Examiner appear to relate to the contents of a datafile. Borghesi appears to teach that the datafile may include data regarding the “extent of damage or injury.” Borghesi, however, is silent as to what is done with the information regarding the extent of injury and does not appear to teach that the extent of injury information is processed in any way. For at least these reasons, and for the reasons recited above with respect to independent claim 16, Appellant submits that claim 21 is patentable over the cited art.

Claim 22

In addition, neither Borghesi nor DeFrancesco appear to disclose, teach, or suggest “one or more treatments of the bodily injuries” as recited in claim 22. The Examiner cites Borghesi, col. 2 lines 20-30 to support the Examiner’s statement, but neither the cited passage nor any other portion of Borghesi appears to teach or suggest insurance claim assessment data comprising bodily injuries and treatments of the bodily injuries. Appellant submits that a person of ordinary skill in the art, at the time of the invention, would not have combined data comprising bodily

injuries and treatments of the bodily injuries with the teachings of Borghesi and DeFrancesco without the benefit of the Appellant's disclosure. Appellant respectfully submits that the Examiner's rejection of claim 22 is based on hindsight speculation not based on the teachings of the prior art. For at least these reasons, and for the reasons recited above with respect to independent claim 16, Appellant submits that claim 22 is patentable over the cited art.

Second Ground of Rejection

Claims 3 and 4 are finally rejected under 35 U.S.C. §103(a) as being obvious over Borghesi in view of DeFrancesco and further in view Aquila.

Claim 3

Claim 3 recites in part "wherein the first set of program instructions comprises a rules engine; and wherein the second set of program instructions comprises a web browser." With respect to this feature the Examiner concedes that "Borghesi and DeFrancesco fail to expressly disclose a rules engine." To remedy the deficiencies of Borghesi and DeFrancesco, the Examiner relies on Aquila. Specifically, the examiner states that "Aquila discloses utilizing business rules and a rules engine in a system for insurance claims processing." Appellant submits that while Aquila appears to teach the use of business rules, Aquila does not appear to teach the use of business rules for estimating a value of an insurance claim.

Appellant's claim 1 is directed to a system in which the first set of program instructions "are executable by the first CPU to estimate a value of an insurance claim as a function of insurance claim assessment data." Claim 3 states, in part, that "the first set of program instructions comprise a rules engine". Thus, claim 3 is directed to a rules engine that, in part, is used to estimate the value of an insurance claim. The rules engine of Aquila, however, is used to generate one or more

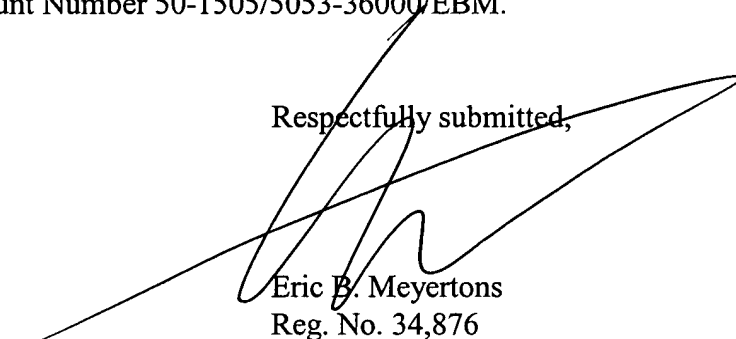
questions related to the collection of insurance claim data. As such, Appellant submits that the reference to Aqwuila fails to teach a rules engine that is capable of estimating a value of an insurance claim.

VIII. Conclusion

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 1-11, 13-18 and 20-22 was erroneous, and reversal of his decision is respectfully requested.

Applicant respectfully requests a one-month extension of time to file the Appeal Brief. A Fee Authorization is attached for the filing of this appeal brief and a one-month extension of time. If any additional extension of time is required, Appellant hereby requests the appropriate extension of time. If any fees are omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-36000/EBM.

Respectfully submitted,



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Date: November 18, 2005

IX. Claims Appendix

The claims on appeal are as follows:

1. A system comprising:

an insurance claim processing server comprising a first CPU and a first memory coupled to the first CPU, wherein the first memory stores a first set of program instructions which are executable by the first CPU to:

estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the first set of program instructions further comprise a sequence of insurance claim processing steps executable to complete an insurance claim transaction, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time; and

a client computer system comprising a second CPU and a second memory coupled to the second CPU, wherein the client computer system is coupled to the insurance claim processing server through a network, wherein the second memory stores a second set of program instructions which are executable by the second CPU to:

receive the insurance claim assessment data entered by a user; and

send the insurance claim assessment data across the network to the insurance claim processing server, wherein the second set of program instructions comprises a sequence of steps established dynamically in real time.

2. The system of claim 1, wherein the insurance claim comprises a bodily injury claim, and wherein the estimate of the value of the insurance claim comprises an estimate of bodily injury general damages.

3. The system of claim 1, wherein the first set of program instructions comprises a rules engine; and wherein the second set of program instructions comprises a web browser.

4. The system of claim 3, wherein the first set of program instructions are further executable by the first CPU to generate and send to the client computer system a plurality of web pages comprising insurance claim assessment questions; wherein the second set of program instructions are further executable by the second CPU to display the web pages comprising the insurance claim assessment questions during the insurance claim consultation session.

5. The system of claim 1, wherein the network comprises the Internet.

6. The system of claim 1, wherein the insurance claim processing server and the client computer system are operable to communicate over the network via TCP/IP.

7. The system of claim 1, further comprising:

a second client computer system comprising a third CPU and a third memory, wherein the second client computer system is coupled to the insurance claim processing server through the network, wherein the third memory stores a third set of program instructions which are executable by the third CPU to:

receive a second set of insurance claim assessment data entered by a second user; and

send the second set of insurance claim assessment data across the network to the insurance claim processing server; and wherein the first set of program instructions are further executable by the first CPU to estimate a value of a second insurance claim as a function of the second set of insurance claim assessment data entered by the second user during a second insurance claim consultation session.

8. The system of claim 1, wherein the insurance claim assessment data comprise one or more bodily injuries and one or more treatments of the bodily injuries.

9. A method comprising:

receiving insurance claim assessment data entered by a user in response to a plurality of insurance claim assessment questions during an insurance claim consultation session; and

sending the insurance claim assessment data across a network via one or more Internet protocols to an insurance claim processing server;

executing insurance claim processing steps on the insurance claim processing server to estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.

10. The method of claim 9, wherein the Internet protocols comprise TCP/IP.

11. The method of claim 9, wherein the Internet protocols comprise HTTP.

13. The method of claim 9, further comprising sending the estimated value of the insurance claim across the network via the one or more Internet protocols to a client computer system.

14. The method of claim 9, wherein the insurance claim comprises a bodily injury claim, and wherein the estimated value of the insurance claim comprises an estimate of bodily injury general damages.

15. The method of claim 9, wherein the insurance claim assessment data comprise one or more bodily injuries and one or more treatments of the bodily injuries.

16. A carrier medium comprising program instructions, wherein the program instructions are computer-executable to implement:

receiving insurance claim assessment data entered by a user in response to a plurality of insurance claim assessment questions during an insurance claim consultation session; and

sending the insurance claim assessment data across a network via one or more Internet protocols to an insurance claim processing server;

executing insurance claim processing steps on the insurance claim processing server to estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.

17. The carrier medium of claim 16, wherein the Internet protocols comprise TCP/IP.

18. The carrier medium of claim 16, wherein the Internet protocols comprise HTTP.
20. The carrier medium of claim 16, wherein the program instructions are further computer-executable to implement sending the estimated value of the insurance claim across the network via the one or more Internet protocols to a client computer system.
21. The carrier medium of claim 16, wherein the insurance claim comprises a bodily injury claim, and wherein the estimated value of the insurance claim comprises an estimate of bodily injury general damages.
22. The carrier medium of claim 16, wherein the insurance claim assessment data comprise one or more bodily injuries and one or more treatments of the bodily injuries.

Scott Lorenz
09/603,303

X. Evidence Appendix

No evidence submitted under 37 CFR §§ 1.130, 1.131 or 1.132 or otherwise entered by the Examiner is relied upon in this appeal.

XI. Related Proceedings Appendix

There are no related proceedings.